

REMARKS

Applicants appreciate the thoroughness with which the Examiner has examined the above-identified application. Reconsideration is requested in view of the amendments above and the remarks below.

Rejection under 35 U.S.C. § 102

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by Peterson (U.S. Patent No. 2,604,132). Applicants respectfully disagree.

Applicants submit that claim 1 required setscrews in contact with at least one blade for pressably securing the blade to a blade retaining plate. Claim 1 (prior to amendment). The Examiner fails to show how the setscrews in the Peterson design make contact with the knife blades. In fact, Peterson does not teach, suggest, or disclose this feature. Referring to Peterson, the Examiner states that "set screws (32) secure the blade to the frame (13) of the upper cutter portion." The Peterson setscrews secure the frame, not the blade(s). In Peterson, the knives 35 are extended between clamping block structures "adjustably mounted in the ends of the frame by screws 32." Peterson, col. 3, ll.12-18; Fig. 1. Clearly, Peterson does not teach having set screws in direct contact with a blade. Peterson teaches the compression of a block structure ("blocks 33 tightly held together") to hold the knife blades in place. "It will be understood that the clamping block structures are spaced from the frame ends only sufficiently to permit placing the knives under some tension." Peterson, col. 3, ll.18-21. The Peterson block structure secures multiple knife blades, and the setscrews compress the block structure. The knife blades are never in contact with the setscrews.

For these reasons, Peterson cannot anticipate the present invention.

The Examiner further states that the current design does not explicitly claim more than a single blade, and as such, removal of a single blade is simply that. Applicants have

amended claim 1 to account for a plurality of blades, particularly multiple piece blade sections, thereby distinguishing the removal of a single blade from a set of blades. "Importantly, in the preferred design, the blade sections may be replaced individually as needed to maintain sharp cutting edges." Specification, ¶ 26.

Applicants respectfully submit that Claim 1, as amended, is also patentably distinct over the cited prior art of Peterson, and as such, Peterson cannot anticipate the invention.

Rejection under 35 U.S.C. § 103

Claims 1 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gifford, et al. (U.S. Patent No. 6,546,833) in view of Milich (U.S. Patent No. 6,003,421), in further view of Scott (U.S. Patent No. 3,720,125), and further in view of Raney, et al. (U.S. Patent No. 6,871,571). Applicants respectfully traverse this rejection.

The Examiner is correct in stating that Applicants consider the combination of Gifford, Milich, and Scott to require a complete redesign of the Gifford structure to even remotely resemble the instant invention. Applicants submit that the Examiner is inappropriately applying hindsight reconstruction to reach an obviousness rejection that is otherwise untenable. Gifford does not teach multiple blade sections that can be independently removable. Gifford also does not teach multiple setscrews to secure the blade sections and allow individual blade sections to be removed independent of the other blade sections. Gifford does not teach or disclose a stripper, and does not have a need for a stripper. Adding these components to the Gifford design runs afoul of its teaching, which uses a single blade piece fabricated from a metal rule die that is held in place by an H-shaped wooded member. Gifford, col. 6, ll.28-32. Gifford's H-shaped wooded member holds the metal rule die, which cuts the piece in its entirety. There is no provision in the Gifford design for holding portions of the metal rule die in the H-shaped wooded member, or more importantly, for removing

portions of the metal rule die while other portions of the metal rule die remain in the H-shaped wooded member. Claim 1, as amended, requires the removal of a single blade section of multiple piece blade sections.

It is the burden of the PTO to establish a prima facie case of obviousness when rejecting claims under 35 U.S.C. § 103. In re Reuter, 651 F.2d 751, 210 USPQ 249 (CCPA 1981). It is respectfully submitted that the Examiner has not made out such a prima facie case. A 35 U.S.C. § 103 rejection based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference is not proper and the prima facie case of obviousness cannot be properly made. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Absent such a showing in the prior art, the Examiner has impermissibly used the Applicants' teaching to hunt through the prior art for the claimed elements and combine them as claimed, but even in such an impermissible hunt, Applicants' invention has not been uncovered. In re Zurko, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997), rev'd on other grounds, Dickinson v. Zurko, 119 S. Ct. 1816, 527 U.S. 150, 144 L.Ed.2d 143 (1999). The Examiner is attempting to combine these prior art references in order to show that the resultant combination would have been obvious to one skilled in the art at the time of the invention. However, based on the positions taken in the above-cited references, at best the Examiner may possibly show that the resultant combination may have been obvious to try.

An "obvious-to-try" situation exists when a general disclosure may pique the scientist's curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued. See generally, In re Eli Lilly & Co., 902 F.2d 943, 945, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990);

In re O'Farrell, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (defining obvious-to-try as when prior art gives "only general guidance as to the particular form of the claimed invention or how to achieve it").

Obvious-to-try has long been held not to constitute obviousness. In re O'Farrell, 853 F.2d at 903, 7 USPQ2d at 1680-81. Specifically, a general incentive does not make obvious a particular result, nor does the existence of techniques by which those effects can be carried out. See also, In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988) (rejecting the "obvious to try" standard).

Applicants respectfully submit that the resultant combination of the prior art references is not obvious to do, even if one ascertains that such a combination would have been obvious to try. At best, in view of these prior art disclosures, one skilled in the art might find it obvious to try to secure multiple blade sections independently by set screws for easy removal and attachment; however, this combination is outside the scope of the Gifford design, and as a practical matter, would most likely not work, insomuch as Gifford's metal rule die is purposely extremely thin material ("die" dimensions) and would be prone to bending and disfigurement under setscrew forces.

Gifford also does not teach a stripper member. There is no structure on the Gifford apparatus to accommodate a stripper, and such a device would require redesign of the Gifford lower portion in order to work properly with the Gifford apparatus. Thus, although possibly obvious to try, the addition of a stripper to the Gifford design is not obvious to do.

Furthermore, having a stripper introduced in the Gifford design would not solve the problem of having the work piece, or segments thereof, fall on the conveyor.

Claim 1 provides that the stripper aids in keeping the material in place when at least one blade is extracted. There is no need for this in the Gifford design since the cutter in

Gifford is made to cut between rows of parts in a conveyor apparatus. Gifford, col. 5, ll.22-25. As each row is cut, it falls to the conveyor.

Applicants submit that the combination of Gifford with a stripper design is not a combination that Gifford can readily accommodate, nor does Gifford have the mechanical structure to allow for the accommodation. Consequently, such a combination cannot render the instant invention obvious.

With regard to claims 2-6 and 10, Applicants submit that the combination of Gifford with the other cited prior art will not overcome the limitations of claim 1, as amended, for the reasons given above, insomuch as Gifford does not teach setscrews in contact with single blades, or a stripper, and the combination of these with Gifford would not be obvious in light of the significant redesign necessary to the Gifford apparatus to accommodate these features.

Applicants are not conceding in this application that the claims as they stood prior to amendment are not patentable over the art cited by the Examiner, as the present claim amendments and cancellations are only for facilitating expeditious prosecution and allowance of the claims. Applicants respectfully reserve the right to pursue these prior and other claims in one or more continuation and/or divisional patent applications.

It is respectfully submitted that the application has now been brought into a condition where allowance of the entire case is proper. Reconsideration and issuance of a notice of allowance are respectfully solicited.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'R. Curcio', is written over a horizontal line.

Robert Curcio
Reg. No. 44,638

DeLIO & PETERSON, LLC
121 Whitney Avenue
New Haven, CT 06510-1241
(203) 787-0595

ibmf100426000-AmendD-AF